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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,347	11/12/2003	Chen Qian Zhao	A01464	6038

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ROHM AND HAAS COMPANY
PATENT DEPARTMENT
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EXAMINER

SASTRI, SATYA B

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/706,347

Applicant(s)

ZHAO, CHEN QIAN

Examiner

Satya B. Sastri

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-8 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/13/04, 4/5/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: EP0653469 Machine Translation.

DETAILED ACTION

1. This office action is in response to application filed on November 12, 2003.

Claims 1-8 are now pending in the application.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. *Claims 1-7*, drawn to an adhesive composition, classified in class 525.
 - II. *Claim 8*, drawn to a method for bonding substrates, classified in class 156.
3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product, such as using it as a coating or a sealant.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. Carl Hemenway on October 7, 2005 a provisional election was made with traverse to prosecute the invention of Group I, *claims 1-7*. Affirmation of this election must be made by applicant in replying to this Office action. *Claim 8* is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102 and 103

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. *Claims 1-4, 7* are rejected under 35 U.S.C. 102(b) as anticipated by Koch et al. (US 5,578,683) or Mallya et al. (US 4,812,541) or Plamhottam et al. (US 5,639,811).

Prior art to Koch et al. discloses pressure sensitive adhesive copolymers formed from acrylic monomers. Working example 1 and example 2 in column 7 disclose a graft copolymer comprising poly methyl (meth)acrylate/glycidyl (meth)acrylate which is further copolymerized

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with acrylic acid and ethylhexyl acrylate. The graft copolymer composition comprises 34.62% solids in the composition.

Mallya et al. disclose pressure sensitive copolymers based on acrylic monomers. The polymerization composition may include 0.1 to 2% by wt. of glycidyl monomer and 0 to 15% by wt. of ethylenically unsaturated carboxylic monomer (column 2, lines 26-37). Working examples 1 and 2 disclose copolymers derived from such monomers and including solvent and copolymers within the instantly claimed range.

Prior art to Planhottam et al. concerns tackified pressure sensitive adhesives comprising a copolymer based on an acrylic backbone, with a glycidyl monomer, unsaturated carboxylic acid monomer and vinyl lactam monomer, and a tackifier (abstract). Copolymer disclosed in example 1 comprises glycidyl methacrylate and acrylic acid and the composition had a solids content of 46.4%. Thus, instant *claims 1-4, 7* are anticipated by the prior art.

9. *Claims 1-4, 6, 7* are rejected under 35 U.S.C. 102(b) as anticipated by EP0653469 ('469, Machine translation).

Prior art '469 discloses ambient curing coating compositions comprising a latex of a polymer derived from the polymerization of acetoacetoxyethyl (meth)acrylate, glycidyl (meth)acrylate, unsaturated acids and one or more copolymerizable monomers. The aqueous compositions may be used in pressure sensitive adhesive compositions (abstract). The solids content may range from 20% to 70% by wt. (page 13). Aqueous compositions may further include a variety of binders based on dispersions of polyester, epoxy, polyurethane and alkyd resins in amounts up to 80% by wt. (page 14).

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10. ***Claims 1-7*** are rejected under 35 U.S.C. 102(b) as anticipated by Kanetou et al. (US 5,728,767).

Kanetou et al. disclose aqueous resin compositions comprising 80 to 10 parts of modified polyolefin having a weight average molecular weight of 1000 to 100,000, modified by copolymerizing polyolefin with an acid anhydride, carboxylic acid or alcohol with radically polymerizable double bond and 20-90 parts of acrylic or methacrylic monomers (abstract). The compositions may form a film and adhesive layer with excellent adhesion, flexibility and water resistance and therefore, are useful as a paint, primer, sealing agent and adhesive (column 1, lines 14-21). Working example 4 discloses copolymerization of cyclohexyl methacrylate, glycidyl methacrylate, methacrylic acid, 2-ethylhexyl methacrylate and modified polyolefin as the macromonomer. The macromonomer is derived from propylene-butene-ethylene copolymer and maleic anhydride. The emulsion comprises 42% solids (column 16, lines 40-56 and column 18, lines 15-41). Water is subsequently added to make up an aqueous dispersion (Table 1).

Conclusion

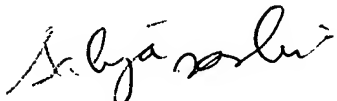
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satya Sastri at (571) 272 1112.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached at (571) 272 1114.

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The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SATYA SASTRI

October 31, 2005



DAVID W. WU
SUPERVISORY PATENT EXAMINER
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